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Supreme Court, U.S.
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NO. _____

IN THE

Supreme Court Of The United States

ARCH LIGHTING GROUP, INC.,
Petitioner,

v.

GENLYTE THOMAS GROUP LLC
Respondent.

On Petition for a Writ of Certiorari
To the United States Court of Appeals
for the Federal Circuit

PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED

1. In determining patent infringement under the doctrine of equivalents, can two elements of a claim which are described and interpreted differently be held to be infringed by two parts of the accused product which are identical?

2. In providing an interpretation of a patent claim that includes an element expressed as a means for performing a function without the recitation of structure, must the Judge indicate to the jury that such an element is to be construed to cover the corresponding structure, material and acts described in the specification and equivalents thereof as set forth in 35 U.S.C. §112, ¶6?

RULE 14.1(b) STATEMENT

A list of all parties to the proceeding in the court whose judgment is the subject of this petition is as follows:

Defendant-Appellant and Petitioner: Arch Lighting Group, Inc. (doing business as Architectural Lighting Systems).

Plaintiff-Appellee and Respondent: Genlyte Thomas Group LLC

CORPORATE DISCLOSURE STATEMENT

Petitioner, Arch Lighting Group, Inc. has no parent corporation nor any public company which holds 10% or more of its stock.

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PETITION FOR A WRIT OF CERTIORARI

Arch Lighting Group, Inc., doing business as Architectural Lighting Systems ("ALS"), respectfully petitions for a writ of certiorari to review the opinion and judgment of the U.S. Court of Appeals for the Federal Circuit.

OPINIONS BELOW

The opinion of the U.S. Court of Appeals for the Federal Circuit, dated May 14, 2008, which was not officially reported, is reproduced at App. A, 1a-11a.

The Final Judgment and Permanent Injunction Following Trial to Jury and Verdict of the U.S. District Court for the District of Massachusetts, dated February 5, 2007, is reproduced at App. B, 12a-16a.

The order denying ALS' Motion for Judgment as a Matter of Law and/or for a New Trial, dated March 29, 2007, is reproduced at App. C, 17a.

JURISDICTION

The judgment of the U.S. Court of Appeals for the Federal Circuit sought to be reviewed was entered on May 14, 2008. This petition is timely under 28 U.S.C. §2101(c) and Supreme Court Rule 13.1 because it is being filed within 90 days of the entry of the opinion and judgment sought to be reviewed. This Court has jurisdiction to review the judgment of the U.S. Court of Appeals for the Federal Circuit pursuant to 28 U.S.C. §1254(1).

STATUTORY PROVISION INVOLVED

A relevant statutory provision involved in this petition is 35 U.S.C. §112, ¶6 of the Patent Act. The relevant statutory provision is reproduced at App. D, 18a.

STATEMENT OF THE CASE

This action arises from a patent infringement suit brought by Respondent, Genlyte Thomas Group LLC ("Genlyte"), against Petitioner ALS. Genlyte is the owner of U.S. Patent No. 5,038,254 ("the '245 Patent")[1] relating to an integrated medical light system. The medical light system, as described in the '254 Patent, is used in patient room over the patient's bed. It has several different fixtures within a body to provide different types of light for different purposes. One light fixture provides light directly below the fixture onto a portion of the bed to allow the patient to read. Another light fixture provides light to the wall at the head of the bed. The light is reflected off the wall to provide ambient or general lighting throughout the room. A third light fixture provides light over the entire bed for the doctor to examine the patient.

Genlyte asserted that the independent claims of the '254 Patent, claims 1 and 3, were infringed by ALS's MulTMed and Latitude products. Claims 1 and 3 both recite "a medical lighting system" comprising various elements. Three of the recited

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[1] The '254 Patent is reproduced at App. F, 21a-25a.

elements, identical in both independent claims, are relevant to this petition, namely:

> means for ceiling-mounting said body;
>
> a first light fixture within said body oriented to direct light downwardly to a selected reading area under said body; and
>
> a second light fixture within said body oriented to direct light downwardly and outwardly to a vertical wall surface outwardly adjacent from said body whereby light is reflected back to a broad area under said body.

The District Court conducted a Markman hearing on June 30, 2006 at which the language relating to the first and second lighting fixtures was interpreted. The Judge interpreted the first light fixture to be "set or arranged to direct or aim more light in a downward direction than in an upward or outward direction to a reading area." The Judge interpreted the second light fixture to be "set or arranged to direct more light in a downward and outward direction than in an upward direction to a wall." An interpretation of the "means for ceiling-mounting said body" was deferred at that time.

A jury trial was held January 22-31, 2007. At the trial, the structures of the accused MulTMed products were identified. The MulTMed products included various combinations of reading light fixtures, ambient light fixtures, and examination light fixtures. However, unlike the fixtures in disclosed and claimed in the '254 Patent, the fixtures

in the MulTMed products do not direct light differently. All of the witnesses, whether testifying for Genlyte or ALS, testified that the accused MulTMed products had light fixtures with substantially identical light distributions – all of the light fixtures direct light in many directions, but mainly downward. There was no testimony from any witness that any light fixture in the MulTMed products directed more light to a wall than to an area downward under the fixture.

On February 1, 2007, the jury returned a verdict finding that some products infringed and others did not.[2] The jury verdict found that: one MulTMed product literally infringed claim 1 of the '254 patent; two other MulTMed products did not literally infringe any of the claims of the '254 patent, but infringed claims 1 and 3 under the doctrine of equivalents; and that another MulTMed product and the Latitude product did not infringe any claims of the '254 patent. On February 5, 2007, the District Court entered judgment against ALS in connection with the jury's verdict.[3]

ALS timely filed a Motion for Judgment as a Matter of Law, to Alter Judgment and/or for a New Trial. ALS's motion was based upon the issues raised herein. Specifically, ALS asserted that the jury's verdict was clearly erroneous and/or against the weight of the evidence in connection with the infringement findings. Since the claims recited light fixtures which direct light differently and the ALS

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[2] The verdict is reproduced at App. D, 19a-20a.

[3] The Judgment is reproduced at App. B, 12a-16a.

products directed light identically, there could be no infringement, either literally or under the doctrine of equivalents. Furthermore, ALS had requested that the jury be instructed with respect to infringement under 35 U.S.C. §112, ¶6 in connection with the "means for ceiling-mounting said body" claim element. The District Court refused to give the requested instruction and told the jury nothing regarding this claim element. The District Court denied ALS' motion.[4]

ALS appealed the District Court's denial of its motion to the U.S. Court of Appeals for the Federal Circuit. On May 14, 2008, the Federal Circuit affirmed the order of the District Court denying ALS's motion. App. 3a. The Federal Circuit held that the first and second light fixtures in the claims, as interpreted by the District Court, did not require light to be directed in different directions, and that the jury could have found the fixtures to be equivalent, although not identical. The Federal Circuit further found that the District Court was not required to instruct the jury with respect to interpretation of a claim element under 35 U.S.C. §112, ¶6.

ALS petitions this Court to review the Federal Circuit decision holding that, under the doctrine of equivalents, a product with two identical parts could be equivalent to claim elements which are claimed and interpreted differently. ALS further petitions this Court to review the Federal Circuit decision holding that a jury does not need to be instructed

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[4] The decision denying ALS' motion is reproduced at App. C, 17a.

with respect to infringement of a claim element falling within 35 U.S.C. §112, ¶6.

REASONS FOR GRANTING THE PETITION

This Court has addressed the issue of infringement under the doctrine of equivalents on various occasions. On such occasions, this Court has expounded upon the difficulties in applying the doctrine of equivalents in a meaningful and consistent manner. In this case, the Federal Circuit has accepted a position which would expand the doctrine of equivalents in a manner which would eliminate the ability of the claims to provide the necessary notice to potential infringers as to what was included within the patent. In particular, under the Federal Circuit's decision, claim elements which are described differently, and interpreted differently, may be infringed by elements in a product which are identical. Such a position conflicts with the statements made by this Court regarding application of the doctrine of equivalents.

This Court has also addressed issues regarding claim interpretation. As held by this Court, the Judge is responsible for interpreting the claim and for providing the necessary instructions to the jury regarding such interpretation. Under 35 U.S.C. §112, ¶6, a claim element reciting a means for performing a function without the corresponding structure must be interpreted to include the structures in the specification. The Federal Circuit's failure to require an instruction regarding such an interpretation omits a necessary, statutory element of a patent claim.

I. THE FEDERAL CIRCUIT'S OPINION REGARDING APPLICATION OF THE DOCTRINE OF EQUIVALENTS TO THE INTERPRETED CLAIM CONFLICTS WITH THE REQUIREMENTS OF THE DOCTRINE AND THE DECISIONS OF THIS COURT

In 1950, this Court set out the contours of what is known as the "doctrine of equivalents" in *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605 (1950). Under this doctrine, a product that does not literally infringe upon the express terms of a patent claim may be found to infringe if there is an "equivalence" between the elements of the accused product and the claimed elements of the patented invention. *Id.* at 609 . However, the application of the doctrine of equivalents under *Graver Tank* has resulting in significant confusion and disagreement within the Court of Appeals for the Federal Circuit. Recently, this Court endeavored to clarify the proper scope of the doctrine in *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17 (1997). Despite the best efforts of this Court, significant confusion and disagreement remains at the Federal Circuit. The present case illustrates a difficulty in application of the doctrine of equivalents which needs to be addressed by this Court.

As noted by this Court, "the doctrine of equivalents, when applied broadly, conflicts with the definitional and public-notice functions of the statutory claiming requirement." *Warner-Jenkinson*, 520 U.S. at 29. In order to avoid such a conflict, this Court set forth certain standards in the application

of the doctrine of equivalents. Specifically, the doctrine of equivalents must be applied to individual elements of the claim, not the invention as a whole. *Id.* Additionally, with respect to an individual element, the application of the doctrine should not be allowed such broad play as to effectively eliminate the element in its entirety. *Id.* Application of these two principals, as suggested by this Court, would substantially eliminate any lack of precision in linguistic frameworks. *Id.* at 40. However, in this case, the Federal Circuit has failed to provide the "special vigilance" against elimination of an element from the claims of the patent. *Id.*

As noted many times by this Court, a invention is defined by the claims of the patent. The claims of the '254 Patent include two light fixtures each of which is oriented to direct light in a certain defined direction to a certain defined target. The directions and targets are different for each of the two fixtures. In interpreting these claims, the District Court indicated that claims required the fixtures to direct or aim more light in the recited direction towards the recited target than in other directions. On the other hand, the accused products have light fixtures which have identical light distributions. The jury found that two ALS products having such light fixtures, the MT2A and MT2B, did not literally infringe the claims of the '254 Patent. However, the jury then found that these two products infringed the claims under the doctrine of equivalents.

On appeal, ALS asserted that the finding of infringement under the doctrine of equivalents was contrary to the evidence because such an application

of the doctrine of equivalents would eliminate an element of the claim. Specifically, if the doctrine of equivalents could be applied so broadly that two different claim elements could be found to correspond to two identical product structures, then one of the claim elements has been eliminated. In addressing this issue, the Federal Circuit found that an element was not eliminated because corresponding structure in the accused product fell within the claim element as interpreted by the District Court. However, this position by the Federal Circuit completely ignores the jury verdict. The jury found that the products did not literally infringe, i.e., that a claim element, as interpreted by the court, was not present in the accused product. It was only by application of the doctrine of equivalents that the products were found to infringe.

The two fixtures in the claims of the '254 Patent are described differently. The District Court also interpreted the two fixtures differently. The jury found that the fixtures in the accused products were not different, and hence did not literally infringe the claims. However, in finding infringement under the doctrine of equivalents, the two different claim elements were applied to identical fixtures. This requires the two different claim elements to be considered equivalent. Thus, under this application of the doctrine of equivalents, one of the elements has been eliminated. In affirming the judgment, the Federal Circuit has consented to the elimination of an element of the claims, contrary to the decisions of this Court.

Despite the care of this Court in setting forth the standards for application of the doctrine of equivalents, it is clear that confusion still remains at the Federal Circuit. In particular, the Federal Circuit has failed to provide the "special vigilance against allowing the concept of equivalence to eliminate completely any [claim] elements." Accordingly, further clarification by this Court is necessary such that a patent can provide the necessary definition and public notice functions. Otherwise, the public cannot rely upon the different language in the claims as requiring different structures within an accused product.

II. THE FEDERAL CIRCUIT'S OPINION REGARDING A MEANS-PLUS FUNCTION CLAIM CONFLICTS WITH THE PATENT STATUTE AND THE DECISIONS OF THIS COURT

This Court has held that the meaning of a claim is a role for the judge. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 384 (1996). The judge must then instruct the jury on the meaning of the claim so that the jury may appropriately apply the claim to the accused product. With respect to certain claim elements, the interpretation of the claim is governed by the Patent Act. In particular, 35 U.S.C. §112, ¶6 provides that claim elements may recite a means for performing a function without recitation of specific structures. However, such a claim element must be interpreted to include the structures disclosed in the specification and their equivalents. This statute was passed in response to this Court's decision in *Halliburton Oil Well*

Cementing Co. v. Walker, 329 U.S. 1 (1946). *See Warner-Jenkinson*, 520 U.S. at 20 (citing *In re Donaldson Co.*, 16 F.3d 1189, 1194 (Fed. Cir.1994); *In re Fuetterer*, 319 F.2d 259, 264, n. 11 (C.C.P.A. 1963)). *Halliburton* rejected claims which did "not describe the invention but use "conveniently functional language at the exact point of novelty,'" 329 U.S. at 8. Thus, under the terms of *Halliburton*, claims could not recite a means for performing a function without the specific structures related thereto. Such claims lacked the necessary limitations as to the necessary structures. In response, in the 1952 Patent Act, Congress specifically provided that such claims were acceptable. The necessary structures were provided by the structures as set forth in the specification and their equivalents.

In the present case, the District Court did not provide the jury with any instruction regarding 35 U.S.C. §112, ¶6 nor its limitations. Thus, the jury was unaware that the claim element relating to ceiling-mounting the body was in any way limited to the structures set forth in the specification and equivalents. On appeal, the Federal Circuit found that the instruction was unnecessary. The Federal Circuit, on its own, reviewed the testimony regarding the specification and the accused products to find sufficient basis for the jury decision on infringement. However, this completely ignores the role of the jury. It is for the jury to apply the claims to the accused product. It is for the jury to determine whether the structures in the specification are the same or equivalent to the accused product. Since the jury was never informed of the necessary comparison, it

could not have made the proper analysis. The Federal Circuit has usurped the role of the jury by failing to require a complete instruction with respect to the statutory limitations on claims.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted,

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